

## **REMARKS**

Reconsideration of the application is respectfully requested.

### **I. Status of the Claims**

Claims 1 - 3 are pending. Applicant amends claims 1 - 3. No new matter is introduced. Support for the amendments may be found, for example, with reference to Applicants' specification at page 5, line 20 through page 8, line 3.

### **II. Rejections under 35 U.S.C. § 112**

Claim 3 is rejected under the first paragraph of 35 U.S.C. § 112 as failing to satisfy the enablement requirement. Specifically, the Examiner finds that the specification fails to disclose "[an] extension unit [that is] provided in a remote-control toy," and suggests that the toy must be instead described as an "overall system." Applicants respectfully disagree.

At page 5, line 20 through page 6, line 9 of the specification, Applicants describe an embodiment of the present invention as follows:

FIG. 1 shows a remote-control toy 1 that is an example of embodiments of the present invention. In the remote-control toy 1, controllers 2A, 2B, 2C, and 2D are respectively paired with automobile models 3A, 3B, 3C, and 3D as driving devices. The controllers 2A, 2B, 2C, and 2D transmit control signals 4A, 4B, 4C, and 4D to the automobile models 3A, 3B, 3C, and 3D, respectively. An extension unit 5 is disposed at such a location as to be able to receive the control signals 4A, 4B, 4C, and 4D.

(Emphasis added).

It is well-accepted that a patentee is entitled to be his or her "own lexicographer" in defining claim terms so long as the meaning of the of terms is clear from the description. *See, e.g.,* MPEP § 2173.05(a)(III). Clearly, in the above-cited passage of the specification, Applicants define a remote control toy that includes a number of distinct components, including controllers,

automobile models and an extension unit. Applicants suggest that it is not unusual to think of a toy of this nature as including a number of interrelated but distinct components. In this case, the descriptor "remote control" merely indicates that the remote control of some components by other components is a capability of the toy. While the term "system" as the Examiner suggests may be an apt descriptor in this case, Applicants submit that it is not the only term that may be used to describe the claimed assembly of components. In this case, Applicants submit that the term "toy," as supported by its use in Applicants' specification, is a suitable descriptor for the assembly.

Therefore, Applicants respectfully request that the rejection of claim 3 under the first paragraph of 35 U.S.C. § 112 be withdrawn.

### **III. Rejections under 35 U.S.C. § 103**

Claims 1 – 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,072,792 to Freifeld ("Freifeld") in view of U. S. Patent No. 5,088,955 to Ishimoto ("Ishimoto"). Applicants amend claims 1 and 3 to further clarify the nature of their invention, and respectfully traverse the rejections of claims 1 – 3 under 35 U.S.C. § 103(a).

In amended independent claim 1, Applicants claim:

**1. A remote-control toy comprising:**

a controller for transmitting a control signal containing an operating instruction based on an operation by a user, the operating instruction including a device identifier;

a driving device for being controlled based on the control signal, the driving device corresponding to the device identifier; and

an extension unit for receiving the control signal, the extension unit comprising:

a unit main body; and

a signal processing device detachably connected to an external portion of the unit main body,

the unit main body comprising:

a signal receiver for receiving the control signal;  
a terminal portion for outputting the received control signal to the signal processing device, the terminal portion corresponding to the device identifier; and  
a processor for processing an instruction signal that is output from the signal processing device,  
the signal processing device comprising:  
a connecting portion that is connected to the terminal portion ;  
a processing determining unit for discriminating the contents of the operating instruction contained in the control signal that is input through the connecting portion, for determining that the control signal includes the device identifier corresponding to the terminal portion, and for determining a processing corresponding to the instruction contents; and  
an instruction signal output unit for producing the instruction signal based on the determined processing, and for outputting the produced instruction signal to the connecting portion,  
wherein the processor determines the processing based on the instruction signal that is input through the terminal portion.

(Emphasis added).

Freifeld discloses a radio-controlled toy (R/C) racecourse for a plurality of racing vehicles. Each of the vehicles includes a sensor that is capable of detecting a unique identifier associated with each of a number of gates along the racecourse, a processor for processing signals output by the sensor and a transmitter for transmitting information output by the processor to a receiver in a scoreboard. Outputs from the received are processed by a microprocessor to produce outputs for the scoreboard, including sound outputs played through a speaker of the scoreboard.

The Examiner acknowledges that Freifeld, in contrast to Applicants' claimed invention, does not teach playing sounds at the scoreboard on the basis of control signals received by the racing vehicles from associated R/C controllers, but suggests that this deficiency is overcome with the addition of Ishimoto.

Ishimoto discloses a sound effect device for an R/C toy vehicle. The device of Ishimoto is provided on the associated vehicle, and is capable of outputting sounds through a speaker provided in each vehicle that depend on a driving condition of the vehicle that is controlled by the R/C controller. The Examiner further acknowledges that the combination of Freifeld and Ishimoto, in contrast to Applicants' claimed invention, fail to teach "the signal processing device detachable from the extension unit, the signal processing device being separate from the processing device of the extension unit, or a terminal and connecting portion." The Examiner however suggests that these features result in the same functions being performed as are suggested by the combination of Freifeld and Ishimoto, and that such further modification would be obvious. Applicants respectfully disagree.

Freifeld teaches a toy racecourse that includes a scoreboard (extension unit) configured for indicating that status of a race (for example, visually posting race results and playing sounds indicating race status). Ishimoto teaches a sound effect device for indicating a current operating status of a race vehicle, which is incorporated in the vehicle. Applicants submit that one skilled in the art at the time of the present invention would not have been motivated to combine Freifeld and Ishimoto in a manner that would place the sound effect device of Ishimoto within the scoreboard of Freifeld to arrive at Applicants' claimed extension unit, but rather would have added the sensors of Freifeld to the vehicles of Ishimoto in order to benefit from the scoreboard features of Freifeld.

Applicants' remote-control toy as claimed includes an extension unit with a detachably-connected signal processing device that executes an extension process directed by a control signal provided by a controller of the driving device. With this claimed construction, the extension process easily changed and/or upgraded by replacing the detachably-connected signal processing device, without making any additional changes to either of the controller and the driving device. Applicants maintain that neither Freifeld nor Ishimoto teach or suggest a toy that provides an extension device that is independent of both a driving vehicle and a controller of the driving vehicle and that receives a control signal from the controller to execute an extension process. Therefore, even assuming *arguendo* that Freifeld's scoreboard can be said to correspond to the extension device of the present

invention, Applicants submit that the combination of Freifeld and Ishimoto would fail to suggest that an extension process of the scoreboard be controlled by a control signal of the controller as claimed by Applicants.

Moreover, even assuming *arguendo* that one skilled in the art at the time of the present invention would have combined the two references in the manner suggested by the Examiner, and as noted by the Examiner, this combination nevertheless fails to teach or suggest Applicants' claimed extension unit having a unit main body and a signal processing device detachably connected to an external portion of the unit main body. More specifically, the combination fails to teach or suggest that the signal processing device is connected to a terminal portion of the unit main body that corresponds to a device identifier, where the device identifier also corresponds to the vehicle ("driving device").

The Examiner suggests that the cited references suggest modifying the scoreboard of Freifeld to receive and discriminate between control signals of respective vehicles as taught by Ishimoto, and that this accomplishes the same function that is performed by Applicants' claimed extension unit. Applicants respectfully disagree.

Applicants' claimed device enables individual signal processing devices to be easily matched with each vehicle according to an associated device identifier. In this manner, different sounds for different types of vehicles may be easily provided by connecting the associated signal processing devices to respective terminals corresponding to device identifiers for respective vehicles. Even if the vehicles all share a common type, different signal processing devices can be applied to individual vehicles to more easily distinguish sounds for the individual vehicles and/or to enable users to select vehicle sounds according to personal preference.

Applicants submit that these aspects indicate a clear functional difference and advantage over any device that may be suggested by the references, and that this functional difference represents more than "mere design consideration" which fails to distinguish over the prior art.

For at least the above-argued reasons, Applicants submit that amended independent claim 1 is not obvious in view of the cited references and stands in condition for allowance. As claim 2 depends directly from allowable independent claim 1, Applicants submit that dependent claim 2 is allowable for at least this reason. As amended independent claim 3 included essentially the same elements above-argued as distinguishing amended independent claim 1 over the cited references, Applicants submit that amended independent claim 3 is also allowable for at least these same reasons.

Therefore, Applicants respectfully request that the rejections of claims 1 – 3 under 35 U.S.C. § 103(a) be withdrawn.

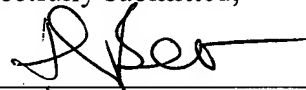
**CONCLUSION**

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance. If there are any remaining issues which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

By



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